



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,741	06/13/2000	Theresa M. Gosko	M-9083-US	7322

24251 7590 05/17/2002

SKJERVEN MORRILL LLP  
25 METRO DRIVE  
SUITE 700  
SAN JOSE, CA 95110

EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 05/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

7A

# Office Action Summary

Application No.

09/592,741

Applicant(s)

Theresa M. Gosko

Examiner

Andrew J. Fischer

Art Unit

3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 2, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 21-29 is/are pending in the application.
- 4a) Of the above, claim(s) 21-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 29, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 3627

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's reaffirmation of the election with traverse of Group I (claims 1-9) in Paper No. 6 is acknowledged. The traversal is on the ground(s) that "each of these claims (sic) sets relate to data structures relating to catalogs and should not be subject to restriction." This is not found persuasive. Even if—albeit a big if—Applicant's argument and conclusion is true, the Examiner is unaware of any authority where claim sets relate to data structures relating to catalogs should not be subject to restriction. For purposes of Applicant's possible petition, the Examiner respectfully request Applicant to cite and provide authority where "data structures relating to catalogs [] should not be subject to restriction."

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 10-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 6.

3. Newly submitted claims 21-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

A method for providing a catalog is distinct from a data structure.

Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

Art Unit: 3627

on the merits. Accordingly, claims 21-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not produce a useful, concrete, tangible result. A data structure alone is non-statutory. See *In re Warmerdam*, 33 F3d 1354, 31 USPQ2d 1754 (Fed Cir 1994). Again, a data structure is not one of the statutory classes of patentable subject matter.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

7. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Art Unit: 3627

- a. Regarding claim 1, the phrase “system type” renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by “system type”), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(b) *E*.
- b. In claim 3, the term “business rule elements” is indefinite.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the Applicant for patent.

9. Claims 1-9, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Spallone et. al. (U.S. 4,959,686). Spallone et. al. discloses a data structure since all computer programs must have some data structure. Specifically see Spallone columns 1-9.
10. Functional recitation(s) using the word “for” (e.g. “for providing a catalog from a manufacturer to a customer” as recited in claim 1) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the

Art Unit: 3627

claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

11. For due process purposes, the Examiner notes Applicant has declined the Examiner's express invitation<sup>1</sup> to indicate and define claim limitations to have a meaning other than their ordinary and accustomed meaning. Therefore, for ex parte examination, the presumption in favor of the ordinary and accustomed meaning is maintained and the claims are interpreted with their "broadest reasonable interpretation . . . ." *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>2</sup> The Examiner will henceforth rely on this interpretation.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

---

<sup>1</sup> See the Examiner's previous Office Action, Paper No. 4, Paragraph No. 18.

<sup>2</sup> See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

Art Unit: 3627

13. Claims 1-9 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Spallone et. al.<sup>3</sup> It is the Examiner's principle position that Spallone et. al. inherently discloses the data structure as discussed above since all computer programs must have at the very least, some data structure and Spallone et. al. discloses a computer with a computer program.

Alternatively, if not inherent in Spallone et. al., the missing claim elements in Spallone et. al. are only found in the nonfunctional descriptive material and are not functionally involved in the claimed subject matter (i.e. any action performed by the claims, if any<sup>4</sup>, is in no way dependent upon the content of the data structure).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the content of Spallone et. al. with any type of content. The descriptive material will not distinguish the claimed invention over the prior art in terms of patentability because the data does not functionally relate to the steps in the method. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowery*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). See also MPEP §2106 IV B.

---

<sup>3</sup> See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

<sup>4</sup> Precisely because no action is performed, a §101 rejection results.

Art Unit: 3627

***Response to Arguments***

14. Applicant's arguments filed with the claim amendments have been fully considered but they are not persuasive.

15. Regarding the §101, Applicant argues the claims are now statutory because they now recite “the data structure is stored on a computer-readable media.” Applicant additionally cites MPEP §2106 stating “a claimed computer readable medium encoded with a data structure . . . is thus statutory.” While the Examiner agrees with the MPEP statement, Applicant has not claimed a computer readable medium—Applicant has nevertheless *still* primarily claimed a data structure.

By way of example, claiming “A cart that is adapted to move a horse” is extremely different from a §101 point of view than claiming “A horse that is adapted to move a cart.” The first is statutory while the other is most likely not. The Examiner respectfully recommends Applicant not put the horse behind the cart but instead place the cart behind the horse. In other words, the Examiner recommends claiming “A computer readable medium encoded with a data structure” and *not* vice versa and to have the claim actually doing something.

16. Regarding the §112 2<sup>nd</sup> paragraph rejections, Applicant has directed the Examiner's attention towards the specification yet has failed to provide the legal basis for referring to the specification. And although the claims are interpreted in light of the specification, limitations

Art Unit: 3627

from the specification are not read into the claims. See *In re Van Guens*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).<sup>5</sup>

### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

---


<sup>5</sup> See also *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998)(citations omitted) (“[W]hile . . . claims are to be interpreted in light of the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claim.”).

Art Unit: 3627


18. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

19. The art unit and technology center for this application has changed. The new art unit is 3627 in technology center 3600. So that papers may be properly matched, please indicated the new art unit on any paper submitted with this application.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

  
ANDREW J. FISCHER  
PATENT EXAMINER  
5/14/02

AJF  
May 14, 2002

  
ROBERT P. OLSZEWSKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600